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REMARKS

Claims 14-34 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the application is requested in view of the comments.

I. Rejection of Claim 14 Under 35 U.S.C. §112, First Paragraph

Claim 14 stands rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Withdrawal of this rejection is respectfully requested for at least the following reasons. The Examiner has not presented evidence or reasons why a person skilled in the art would not recognize a description of the claimed invention in the specification.

The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. 541 F.2d at 265, 191 USPQ at 98. See also *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Inter. 1987).

Moreover, the contended matter relating to a computer controlling display options is conventional and well known in the art, and therefore need not be disclosed in detail.

What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94.

Claim 14 recites a *microcomputer* that provides a *display option* in accordance with the horizontal configuration to orient display information on the display based at least in part upon whether a user selects a left hand or right hand display option. The Examiner contends that such microcomputer controlled display is not supported in the specification. However, applicants' representatives submit that the claimed subject matter is supported as discussed in detail below.

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In particular, the scanning device *display* in the claimed invention is orientation selectable to render a vertical and a horizontal display wherein the horizontal *display is configurable for left-hand and right-hand users*. (See page 5, first paragraph). It is well known in the art that a display itself is a "dumb" component. That is, a display is typically an output device that displays signals that are transmitted in an appropriate format. Some displays can further act as an input device (e.g., touch sensitive screen) wherein a touch-sensitive transparent panel is employed to cover the screen in order to sense an event (e.g., electrical in nature such resistive and capacitive) and transmitted a signal. Without a device to transmit or receive a display signal, the display does not provide a usefulness.

A microcomputer (as well as a personal computer, minicomputer, ASIC and the like) can provide such display signal transmitting and receiving ability. The microcomputer can be considered the "brain" or control mechanism of a device. For example, microwaves, automobile digital read-outs, bar code scanners and digital watches employ a microcomputer(s) for user interaction such as customizing the display including display orientations. The claimed invention provides such *microcomputer*. (See page 4, second paragraph).

Since *computer and display technology were well known in the art at the time of the invention*, it is obvious that the operation and configuration of a display (e.g., display orientation) is provided by a microcomputer as claimed in the subject invention. Accordingly, it is respectfully submitted that the object be withdrawn.

II. Rejection of Claim 14 Under 35 U.S.C. §112, First Paragraph

Claim 14 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Withdrawal of this rejection is respectfully requested for at least the following reason. Applicants' representatives submit that the invention as recited in claim 14 is not indefinite since the Examiner's interpretation of the claimed invention is correct. Accordingly, withdrawal of the rejection is respectfully submitted.

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III. Rejection of Claims 14-17, 20-24, 28-29, and 32-34 Under 35 U.S.C. §103(a)

Claims 14-17, 20-24, 28-29, and 32-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable by Petteruti, *et al.* (US 5,335,170) in view of Tracy, *et al.* (US 5,979,757).

Withdrawal of this rejection is respectfully requested for at least the following reasons. Petteruti, *et al.* and Tracy, *et al.*, individually and in combination, do not teach or suggest all claim limitations as recited in the subject claims.

To establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See* MPEP § 2143.03.

Furthermore, Petteruti, *et al.* teaches away from the claimed invention.

[T]eaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

Assuming *arguendo* that Petteruti, *et al.* and Tracy, *et al.* could be combined, neither Petteruti, *et al.* nor Tracy, *et al.* provide a suggestion or motivation to combine in a manner that would result in the claimed invention.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). *See also In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992)

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In particular, claim 14 recites a microcomputer that provides a user selectable horizontal display orientation option to display information in *a left hand or a right hand display orientation* wherein the user determines the orientation by selecting either a left hand or a right hand orientation option. Petteruti, *et al.* and Tracy, *et al.* alone or in combination do not teach such subject matter as claimed. In fact, Petteruti, *et al.* and Tracy, *et al.* are *indifferent* to right handed and left handed people and do not provide a device that accommodates a right handed and a left handed person. Accordingly, neither Petteruti, *et al.* nor Tracy, *et al.*, individually or in combination, teach or suggest the claimed invention.

Furthermore, Petteruti, *et al.* teaches *away* from providing a left hand or a right hand display orientation. Petteruti, *et al.* teaches a master module is interconnected with a scanning module utilizing interconnectors 38 (*i.e.*, the module interconnect) and 39 (*i.e.*, the scanner interconnect). (See col. 3, line 60 – col. 4, line 6). Utilizing the interconnectors 38 and 39 renders the configuration of Fig. 2A wherein the master module is in a configuration such that the person employing the device can utilize the key pad and the display concurrently. To achieve this configuration, the master module of Petteruti, *et al.* is constructed such that a display is located above a key pad as shown below. (Also See Fig. 1, Fig. 2D and col. 2, line 29).

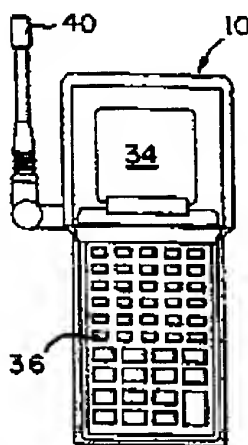


Fig. 1. Master module of Petteruti, *et al.*

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Petteruti, *et al.* teaches away from display orientations other than where the displayed information is oriented with the key pad because other display orientations (e.g., left hand and right hand) would rotate *the displayed information 90 degrees relative to the key pad*. Utilizing such a display and key pad would be extremely difficult because a user would have to constantly rotate the scanner in order to utilize the display and key pad, thereby lessening the usefulness on the scanner. Therefore, not only does Petteruti, *et al.* not teach or suggest the invention as claimed, but Petteruti, *et al.* teaches *away* from the claimed invention.

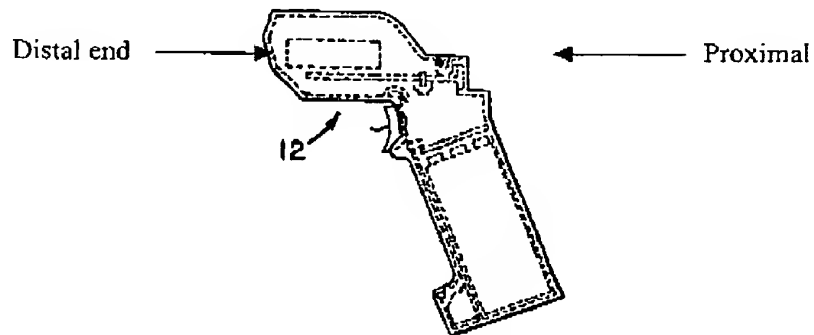
Assuming that Petteruti, *et al.* and Tracy, *et al.* were combinable, a suggestion or motivation to combine Petteruti, *et al.* and Tracy, *et al.* to result in the claimed invention is *absent*. Particularly, Tracy, *et al.* teaches a portable shopping system that includes a portable display wherein a portable scanner is attached and can be detached such that the detached, displayless portable scanner can be employed by the user. (Col. 4, lines 42-46). Clearly, if it were obvious to combine and integrate the display orientations of Tracy, *et al.* and the portable scanner of Petteruti, *et al.*, then Tracy, *et al.* *would have combined* their display orientations with their portable scanner. Furthermore, even if Tracy, *et al.* would have combined such subject matter, still absent would be a left hand and a right hand orientation as in the claimed invention.

In view of the above, it is readily apparent that there is no suggestion or motivation to combine Petteruti, *et al.* and Tracy, *et al.*, that combining them would not result in the claimed invention and that Petteruti, *et al.* teaches away from the claimed invention. Accordingly, withdrawal of the rejection of claim 14 and the claims that depend therefrom (dependent claims 15-17 and 20) is respectfully submitted.

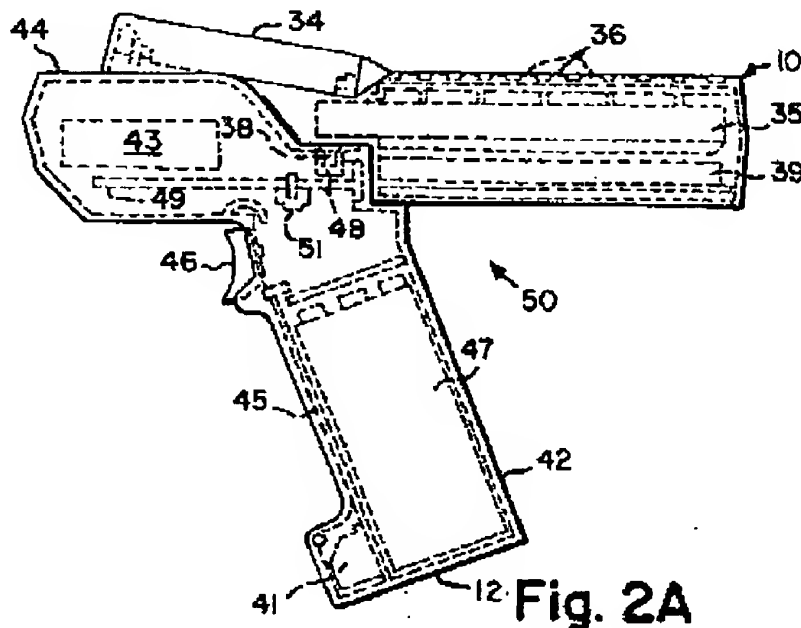
Claim 21 recites a *handle* that extends from a bottom surface of the body at a first *distal end* to increase a viewing angle of the *display*, the handle being joined to the body to cause a proximal end of a bottom surface of the body to rest on a radial surface of a user's hand. In contrast, Petteruti, *et al.* teaches a gun shaped scanner module having a handle portion wherein the handle portion is located at the proximal end (not the distal end, as claimed) of the scanner module as illustrated in Fig. 1 and shown below. From the figure, it can be seen that the handle mates with the lower portion at the proximal end.

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Fig. 1. Gun shaped scanner module of Petteruti, *et al.*

The master module discussed *supra* can interconnect with the scanner module above to form the portable scanner presented below. (See Fig. 2A). From the figure, it is apparent that even after connecting the master module to the scanner module, the scanner module handle is at most located about the center of the body of the device.

Fig. 2A. Scanner module with master module of Petteruti, *et al*

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Tracy, *et al.* does not make up for the deficiencies of Petteruti, *et al.* with respect to the subject claimed invention. As described *supra*, Tracy, *et al.* teaches a portable shopping system wherein a portable display and portable scanner can be joined and employed concurrently. The scanner of Tracy, *et al.* can be detached; however a detached scanner does not include a handle connected at a distal end and/or a display as recited in the claimed invention. In view of the above, it is respectfully requested that the rejection of independent claim 21 and claims 22-24, 28-29, and 32-34, which depend therefrom, be withdrawn.

II. Rejection of Claims 18-19, 25-27, 30-31 Under 35 U.S.C. §103(a)

Claims 18-19, 25-27, 30-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by Tracy, *et al.* and in further view of Reynolds, *et al.* (US 5,828,052). Withdrawal of this rejection is respectfully requested for at least the following reasons. Petteruti, *et al.*, Tracy, *et al.* and Reynolds, *et al.*, individually and in combination, do not teach or suggest all claim limitations as recited in the subject claims.

To establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP § 2143.03.

Reynolds, *et al.* does not make up for the aforementioned deficiencies of Petteruti, *et al.* and Tracy, *et al.* with respect to independent claims 14 and 21, which the subject claims depend from. In particular, Reynolds, *et al.* teaches a hand held scanner, however the scanner does not have a display with configurable orientations for a left handed and a right handed user. Accordingly, it is respectfully submitted that this rejection should be withdrawn.

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Conclusion

The present application is believed to be condition for allowance, and in view of the above remarks, a prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,

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